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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/016,118

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Masahiro Yanagi

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07/30/2004

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EXAMINER

BELL, PAUL A

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 07/30/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/016,118

**Applicant(s)**

YANAGI, MASAHIRO

**Examiner**

PAUL A BELL

**Art Unit**

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider et al. (6,356,243).

With regard to claim 1, Schneider teaches an input device (figure 2a, item 210 ) in that an input part for inputting information is accommodated in a housing there of (column 5, lines 21-28, figure2a item 215 ), said input device comprising an antenna arranged at an upper surface inside said housing and emitting a radio wave based on input information generated by said input part (figure 2a clearly shows dotted lines indicating the antenna item 240 inside the housing and column 5, lines 20-65 ) wherein said housing comprises: a case and an upper cover (figure 2a, item 215 teaches the outer surface of the device with electronics an antenna inside and since there is a solid line running semi vertical on the surface, let left of line be called the cover and right of line be called case and further it is inherent that there would be a means of getting the electronics inside the surface which encloses a volume) wherein said antenna is arranged inside said upper cover at an uppermost portion of the housing (figure 2a clearly shows dotted lines indicating the antenna item 240 inside the housing also see column 6, lines 33-42, this language is broad open to multiple interpretations and

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Schneider clearly shows one such reasonable interpretation of an antenna inside a volume created by the cover), wherein the input device further comprises: a communicating part provided to said case and supplying transmission signal to said antenna, and wherein said antenna is detachably connected to said communicating part by a connector (figure 2b, items 235, 245a and 245b and see column 6, lines 18-32 and further the term "detachably" is viewed broadly because part of the antenna is attached at connection points 245a and 245b by some means such as pressure or solder and in the case of solder, a solder gun would have been simply used to detach it and therefore this reference clearly anticipated the mere functional recitation of the antenna being "detachably" ).

With regard to claim 2, Schneider teaches the input device as claimed in claim 1, wherein said antenna is made from a conductive wire rod (inherent feature of an antenna because it must conduct a signal).

With regard to claim 3, Schneider teaches the input device as claimed in claim 1, wherein said antenna is formed by printing a conductor on the upper surface inside said housing (See abstract "The first portion and the second portion form an antenna loop. The first portion may be etched on a printed circuit board" ).

With regard to claim 6, Schneider teaches the input device as claimed in claim 4, wherein said input part is detachably connected to said communicating part by a connector (inherent feature for example the wheel or buttons on this mouse must connect to the communicating part and it is inherent that parts that connect can also be

capable of disconnect or disassembly therefore broadly reading on "detachably connected").

With regard to claim 11, Schneider teaches a wireless input device to be manipulated by a user (figure 2a, item 210) and, wherein the input device comprises: a case; an upper cover that is connected to the case to form an inside volume (figure 2a, item 215 teaches the outer surface of the device with electronics an antenna inside and since there is a solid line running semi vertical on the surface, let left of line be called the cover and right of line be called case and further it is inherent that there would be a means of getting the electronics inside the surface which encloses a volume) ; and an antenna, which is located at an uppermost portion of the inside volume (figure 2a clearly shows dotted lines indicating the antenna item 240 inside the housing and column 5, lines 20-65 ), to wirelessly transmit a radio wave that comprises coordinate data to a receiving unit that is connected to a processing unit connector (figure 2b, items 235, and figure 1a , items 130 and 110 and figure 1b item 110).

With regard to claim 12, Schneider teaches the wireless input device of claim 11, further comprising: a radio transmitting circuit board that is contained within the inside volume (figure 2b, item 235), wherein the antenna is a conductive wire rod that is connected to the radio transmitting circuit board at only one end of the conductive wire rod (figure 2b, items 245a and 245b , inherent feature of an antenna because it must conduct a signal).

With regard to claim 13, Schneider teaches the wireless input device of claim 11, wherein the antenna is formed by a printed wiring method on an underside of

the upper cover (See abstract "The first portion and the second portion form an antenna loop. The first portion may be etched on a printed circuit board" column 6, lines 32-42 which reads on this broad language of being on the underside of the upper cover see figure 2a , items 215 and 220).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (6,356,243).

With regard to dependent claims 7-10 which all depend on claim 1 Schneider does not illustrate the detail of a specific common standard wireless transmitting techniques "USED" such as Amplitude Shift Keying (ASK), Frequency Shift Keying (FSK), Phase Shift Keying (PSK) and Spread Spectrum Communication (SSC) however since he does perform a wireless transmission it is clear he must use some modulation technique and the specific transmitting technique used is clearly not critical to the practice of either Schneider or Applicant. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to use any common standard wireless modulation techniques, because Schneider gave no indication that the particular common standard wireless modulation technique use would be critical to practice of his invention and again one is always motivated to use standard excepted practices where ever details are missing when implementing the Schneider invention.

***Response to Arguments***

5. Applicant's arguments filed 6/23/2004 have been fully considered but they are not persuasive.

The applicant argues on page 4 and 5 with regards to independent claim 1 that Schneider does not teach "antenna arranged inside an upper cover at an uppermost portion of the housing" and with regards to claim 11, "antenna located at an uppermost portion of an inside volume". The examiner disagrees with this narrow interpretation of the claim language and references the more detailed claim rejection above. Is the applicant trying to claim that a portion of the antenna is imbedded inside the structural material that makes up the cover wherein the cover has a outer surface and inner surface and a volume between the two surfaces is where a portion of antenna is. In contrast to an antenna just inside the inner surface of cover wherein the inner surface of cover creates a volume.

The applicant argues claims 7-10 on pages 5 and 6. The examiner disagrees and references the rewritten rejection which should address your concerns. In any case the examiner fails to understand how the use of any common standard wireless modulation technique would be the single feature that overcomes the prior art and makes your device novel please explain the concept.

**Conclusion**

6. The prior art made of record and not relied upon is considered very pertinent to applicant's disclosure.

Junod et al. (5,854,621) teaches a mouse which uses FSK.

Chen (6,373,469) teaches a mouse which uses ASK.



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Vrbanac (5,708,458) teaches both PSK and FSK.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019.

If attempts to reach the examiner by telephone are unsuccessful the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377 can help with any inquiry of a general nature or relating to the status of this application.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or Faxed to: (703) 872-9306

Or Hand-delivered to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor  
(Receptionist).

*Paul Bell*  
Paul Bell  
Art unit 2675  
July 23, 2004

*Chanh Nguyen*  
CHANH NGUYEN  
PRIMARY EXAMINER